

Werner 2003-0210

Remarks

Reconsideration of remaining claims 1, 3-6 and 8-11 is respectfully requested.

In the Office action dated September 18, 2007, the Examiner rejected the pending claims under 35 USC §§ 102(e) and 103(a). The Examiner's various rejections will be discussed below in the order presented in the Office action.

35 USC § 102(e) Rejection - Claims 1, 5, 6, 10 and 11

The Examiner rejected the above-cited claims under 35 USC 102(e) as being anticipated by US Patent 6,920,478 (Mendiola et al.). Applicant cannot agree with the Examiner's characterization of Mendiola et al. as teaching the use of different IM "groups" and transmitting updates/alerts to only selected "groups". In contrast, Mendiola et al. is associated with monitoring the "on line" status of IM users, based upon the timestamp for the last transmission by an IM user. There is no discussion of transmitting "alert" messages from the "administrator" to only selected (targeted) IM groups.

In order to allow this application to progress to allowance, applicant has amended independent claims 1 and 6 to include the limitations of dependent claims 2 and 8, respectively. This subject matter is directed to transmitting an email "alert" to those members that are not involved in an IM session when the alert occurs. The use of such an email alert transmission is not disclosed or suggested (or anticipated) by Mendiola et al. Thus, applicant respectfully requests the Examiner to reconsider this rejection (in light of these amendments) and find claims 1, 5, 6, 10 and 11 to be in condition for allowance.

35 USC § 103(a) Rejection - Claims 2, 3, 7 and 8

The Examiner next rejected claims 2, 3, 7 and 8 under 35 USC 103(a) as being unpatentable over Mendiola et al. (as above), when considered with US Patent 6,301,609 (Aravamudan et al.). where Aravamudan et al. was cited by the Examiner as teaching a website administrator that transmits email alerts to IM members not currently involved in the IM session.

Werner 2003-0210

Applicant cannot agree with the Examiner's characterization of the Aravamudan et al. reference. Indeed, this reference is properly directed to monitoring various types of messaging associated with an IM member, and allowing the IM member to know that (perhaps) an email message has been sent to him during the course of the IM session. There is no email transmission from the administrator to the IM member in Aravamudan et al. The Examiner also suggested that Mendiola et al. may also teach the transmission of an email message (even if the email address is not stored). Again, applicant cannot agree. The cited portion of the Mendiola et al. text is associated with storing a variety of user information, including the user's "IP address". This is the address of the connection, not the "email address" of the user, as used in the system and method of the present invention.

Based on the above, therefore, applicant asserts that the combination of Mendiola et al. and Aravamudan et al. cannot be found to render obvious the subject matter of the present invention as defined by amended independent claims 1 and 6, or claims 3 and 8 which depend therefrom.

Applicant believes that with these amendments, remaining claims 1, 3-6 and 8-11 are now in condition for allowance. If for some reason or other the Examiner does not agree that the case is ready to issue and that an interview or telephone conversation would further the prosecution, the Examiner is invited to contact applicant's attorney at the telephone number listed below.

Respectfully submitted,

Carl Edward Werner

By: Wendy W. Koba
Wendy W. Koba
Reg. No. 30509
Attorney for applicant
610-346-7112

Date: Dec. 10, 2007